In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. .....

THE I. T. S. COMPANY,
Petitioner,

v.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

BRIEF IN SUPPORT OF PETITION.

I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is reported in 53 U. S. P. Q. 627, and is reproduced at pages 431 to 438 of the Record. The District Court's Findings of Fact and Conclusions of Law are reproduced at pages 454 to 458 of the Record.

The opinion of the Sixth Circuit Court of Appeals is reported in 134 F. (2) 871, and is reproduced at pages 484 to 490 of the Record.

II.

JURISDICTION.

1. This is a suit arising under the patent laws of the United States, 28 U. S. C. 41 (7). Jurisdiction is given this Court by 28 U. S. C. 347. (Sec. 240 (a) of the Judicial Code as amended by the Act of February 13, 1925.)

2. The date of the judgment which petitioner seeks to have reviewed is April 12, 1943. (R. p. 483.) Rehearing was denied June 2, 1943. (R. p. 511.)

3. Among the cases believed to sustain jurisdiction to issue the writ, where questions of federal law of far-reaching public importance are involved, even where there is no specific conflict between different circuits, are:

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126;

Muncie Gear Works v. Outboard Marine & Mfg. Co., 315 U. S. 759.

4. Among the recent cases in which the court has issued the writ of certiorari where there is diversity of decision between the District Court and the Court of Appeals are:

Paramount Publix v. Tri-Ergon, 294 U. S. 464;
Duplate v. Triplex, 298 U. S. 448.

5. This Court has always and consistently reviewed questions on which courts of appeals below are in dispute.

III.

SUMMARY OF ARGUMENT.

Point A: The District Court decided the question of the presence of invention, the only issue in the case, "objectively," in accordance with the recommendation of the National Patent Planning Commission appointed by President Roosevelt; the Court of Appeals reversed the District Court, deciding the question "subjectively" and, therefore, contrary to the recommendation of such Commission. The decision of the Court of Appeals should be reversed and the recommendations of the Commission should be adopted and followed.

Point B: The Court of Appeals decided the question of invention "subjectively" from the standpoint of what

would be "obvious" to the workers in an art different from that to which the patent relates. In so doing, the Court decided the case on an issue not made up by the pleadings, upon which no evidence was offered by respondent, and upon which evidence proffered by petitioner was objected to and excluded. The Court of Appeals should have remanded the case for evidence and findings on this issue before deciding the case upon it.

IV.

ARGUMENT.

Point A.

Manifestly, nothing in the patent law could be so important to the public now as rulings by this Court which would bend the patent law and conform the practice at the Bar and Bench to the recommendations of the National Patent Planning Commission and make it unnecessary for Congress to pass laws whose only effect would be the interpretation of present laws and which rulings of this Court would gain the advantages of such laws without waiting for their passage.

As we have said, the President issued an Executive Order in 1941 to establish this Commission for the following purposes, as stated in that order:

> "2. The Commission is authorized, in conjunction with the Department of Commerce, to conduct a comprehensive survey and study of the American patent system, and consider whether the system now provides the maximum service in stimulating the inventive genius of our people in evolving inventions and in furthering their prompt utilization for the public good; whether our patent system should perform a more active function in inventive development; *whether there are obstructions in our existing system of patent laws, and if so, how they can be eliminated*; to what extent the Government should go in stimulating inventive effort in normal times; and what methods and

plans might be developed to promote inventions and discoveries which will increase commerce, provide employment, and fully utilize expanded defense industrial facilities during normal times." (Emphasis ours throughout.)

The President then appointed the following members of the Commission:

Chairman, Charles F. Kettering, an outstanding practical engineer-scientist of our time.

Chester C. Davis, who needs no introduction to this Court.

Francis P. Gaines, the President of Washington-Lee University, and an educator of great skill and prominence.

Edward F. Grady, who needs no introduction to this Court, and

Owen D. Young, also highly skilled in business and in engineering and science.

This Commission conducted numerous hearings, taking testimony from those skilled in all branches of engineering, science, law, and allied subjects, some of whom were in favor and some against the patent system. Its survey was comprehensive and its study profound. In June, 1943, it handed down its Report to the effect that the American patent system is the foundation of American enterprise, has demonstrated its value, has stimulated invention, made the American people and Government leaders in the world, and that it should be continued. We quote from the Report of the Commission, as follows:

"1. The Patent System of the United States. The Patent System is the foundation of American enterprise and has demonstrated its value over a period coextensive with the life of our government. The principle of recognizing a property right in intellectual creation is sound and should be continued as contemplated in the Constitution."

* * * * *

"The American patent system established by the Constitution giving Congress the 'power to promote the progress of science and useful arts,' is over 150 years old. The system has accomplished all that the framers of the Constitution intended. It is the only provision of the government for the promotion of invention and discovery and *is the basis upon which our entire industrial civilization rests.*

"The American people and their government should recognize the fundamental rightness and fairness of protecting the creations of its inventors by the patent grant. The basic principles of the present system should be preserved. *The system has contributed to the growth and greatness of our nation*; it has:

(1) encouraged and rewarded inventiveness and creativeness, producing new products and processes which have *placed the United States far ahead of other countries in the field of scientific and technological endeavor;*

(2) stimulated American inventors *to originate a major portion of the important industrial and basic inventions of the past 150 years;*

(3) facilitated the rapid development and general application of new discoveries in the United States *to an extent exceeding that of any other country*;

(4) contributed to the achievement of the highest standard of living that any nation has ever enjoyed;

(5) *stimulated creation and development of products and processes necessary to arm the nation and to wage successful war*;

(6) contributed to the improvement of the public health and the public safety; and

(7) operated to protect the individual and small business concerns during the formative period of a new enterprise.

"*The strongest industrial nations have the most effective patent systems and, after a careful study, the Commission has reached the conclusion that the Ameri-*

can system is the best in the world. However, as with any system of long standing, conditions arise which were not foreseen at the time of its establishment. *The American patent system should be adjusted to meet existing conditions without destroying its basic principles.*"

After noting that the American patent system had not only not interfered with the war effort, but had helped that effort, the Commission proceeded to make recommendations for adjustment of the system which would bring it abreast of existing conditions and make it more helpful to the American people and the American Government. Among these of particular interest here is the one which recommended the determination of the question of invention and mechanical skill "objectively" and not "subjectively." The portion of the Report which deals with this subject is as follows:

"V—UNIFORM STANDARD OF INVENTION

"A. Declaration of National Policy.

"*The most serious weakness in the present patent system is the lack of a uniform test or standard for determining whether the particular contribution of an inventor merits the award of the patent grant.* The patent statute itself is quite specific. R. S. 4886 provides that a patent may be obtained by 'any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * upon payment of the fees required by law and other due proceedings had.' The difficulty of applying this statute arises out of the presence of the words 'invented' and 'discovered.' Novelty alone is not sufficient, nor is utility, nor is the final accomplishment. There must also be present some mysterious ingredient connoted in the term 'invented.'

"*Many different and unrelated tribunals now are forced to make their individual decisions,* among them being the Patent Office, the several district courts, the various courts of Appeals and the Supreme Court.

The difficulty is that there is no accepted uniform standard among these several tribunals which can be applied in the same or similar cases. There is an ever widening gulf between the decisions of the Patent Office in granting patents and decisions of the courts who pass upon their validity. It would be highly desirable and a great step forward if patents could be issued with a greater assurance that their validity would be upheld by the courts. *No other feature of our law is more destructive to the purpose of the patent system than this existing uncertainty as to the validity of a patent.* The admonition is frequently heard that there should be 'fewer and better patents,' an impossible accomplishment so long as the present divergence of standards between the Patent Office and the courts and the several courts themselves obtains. Whether the standard of the Patent Office is too low or that of the courts is too high is not for us to determine. *There should be a uniformity in the grant and treatment of patents. The present confusion threatens the usefulness of the whole patent system and calls for an immediate and effective remedy.*

"It is inconsistent with sound national policy to continue to grant patents with existing uncertainty as to their validity, and unfair to the inventors of this country and to manufacturers and inventors who have proceeded on the basis of a protective security in the form of a patent issued to them by the Federal Government. The Commission feels that not one but several steps should be taken to remedy the present situation. A promising improvement would be for Congress, by legislative enactment, to lay down a reasonable, understandable test by which inventions shall be judged both from the standpoint of the grant of the patent and the validity of the patent thereafter.

"The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

> We call particular attention to the recommendation of "the enactment of a declaration of policy that patentability shall be determined objectively" and not "subjectively,"

appended to the above recommendation and that this should be done immediately and effectively. This can only be construed as an invitation to this Court to enact such a declaration of policy since it is within the power of this Court to do so, thereby stilling the controversy that has raged on this subject, as the Commission points out, over many years, among the various tribunals to whom the subject is presented and furnishing the inventing public, the engineering and scientific peoples, the patent bar, the patent Courts, and business, with a rule or yardstick upon which some dependence can be placed.

It is equally manifest that the stilling of this controversy should be done expeditiously and without the need of enactment by Congress as the Commission suggests might be resorted to as a last resort.

The instant case presents the question squarely and offers an opportunity for a prompt enactment of a declaration of the policy without the need of a law of Congress.

There is at Present Diversity of Decisions between the Courts of Appeals (in the 7th and 2nd Circuits for Example) About the Use of the "Objective" or the "Subjective" Tests:

There has been a long and intense struggle among the various Courts below at circuit and in district concerning the use of the objective test and the subjective test; at the present time there is a diversity of decision among the Courts of Appeals as to its application, some holding to the objective view and some to the subjective view. The interpretation of all the Courts has been that a decision objectively is predicated upon the history and a decision subjectively is based upon the "divination" of the Court. We

find such comments and holding on the subject as the following among the various courts:

In *Wahl Clipper Corporation v. Andis Clipper Co., et al.*, 66 Fed. (2) 162, Judge Alschuler for the Court of Appeals in the Seventh Circuit said (p. 165):

> "In most instances, the judgment of those who pay their money to secure the benefits of the patented article is truer and better than the opinion of experts or the speculations of an arbitrator. Inasmuch as experience is more reassuring than theorizing, and history more certain than prophecy, so the test of public approval, if uninfluenced by detracting factors, must afford the weightiest proof obtainable determinative of invention. In short, in construing the patent statute, which was enacted to promote the useful arts, it is more important to study those developments of the art which are bright with use in the channels of trade than to delve into abandoned scrap heaps and dust-covered books which tell of hopes unrealized and flashes of genius quite forgotten. The somewhat meaningless terms 'inventive genius' and 'mechanical skill' must be clarified by an examination of the article itself, and if the improvement be unusual, or if there be doubt, and the public has given its tribute, the judge should accord to the creator of the article the title of inventor."

This is the objective test and its application.

Contrast these pronouncements of the practice in the Seventh Circuit with the following pronouncement of the practice in the Second Circuit in *Kirsch v. Gould*, 6 Fed. (2) 793, 794:

> "Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications in the existing arts as are within the limited imagination of the journeyman. There comes a point when the question must be resolved by a subjective opinion as to what seems an easy step and what does

not. We must try to correct our standard by such objective references as we can, but in the end the judgment will appear, and no doubt be, to a large extent personal, and in that sense arbitrary."

There is Diversity of Decision Among the Courts of Appeals Below as to What Standard of Invention This Court Has Set or Desires Shall be Set: There seems to be a consensus of opinion that this Court has changed the standard of invention, but a variety of views varying widely on the question of what standard this Court desires shall be observed. This is illustrated by the following from the decision of the Sixth Circuit Court of Appeals in *U. S. Gypsum v. Consolidated*, 130 Fed. (2) 888, 892:

> "Much difficulty has, of course, been experienced by the courts in determining what improvements lie within the expected skill of the art. We adverted to this in *Cleveland Trust Co. v. Schriber-Schroth Co.*, 6 Cir., 92 F. 2d 330, 334. Older cases are not very helpful. The patent law is presently in a state of flux. Much water has flowed over the patent dam and we must recognize as have other courts and our own (*Cleveland Trust Co. v. Schriber-Schroth Co.*, 6 Cir., 108 F. 2d 109) 'the high standard demanded for invention by the decisions of the Supreme Court in recent years,' (*Buono v. Yankee Maid Dress Corp.*, 2 Cir., 77 F. 2d 274, 276). We cannot 'ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent,' (*Picard v. United Aircraft Corp.*, 2 Cir., 128 F. 2d 632, 636), and that it is our 'duty, cautiously to be sure to follow not to resist.' (*Perkins v. Endicott Johnson Corp.*, 2 Cir., 128 F. 2d 208, 218). This is imperative even though *we are unable to go the whole way with Judge Learned Hand* in his observation in the Picard case, *supra*, if correctly interpreted in the concurring opinion in that case as 'a negative test' by which it is determined that 'nothing is an invention which is * * * progress * * * through trial and error.' We remember that the pat-

ent law rewards both invention and discovery and that genius has well been defined as 'an infinite capacity for taking pains.' If the story of Edison's long continued search for an incandescent lamp filament be true, his genius responds to the definition."

Here it is to be noted that Judge Simons, who wrote the opinion, announced that the Court of Appeals in the Sixth Circuit is "unable to go the whole way with Judge Learned Hand" who spoke for the Second Circuit Court of Appeals. This is a direct pronouncement by the Sixth Circuit Court of Appeals that it is in disagreement with the Second Circuit Court of Appeals on the subject.

The District Court Decided the Case "Objectively" in Accordance with the Recommendation of the Commission:

The District Judge said (R. p. 434):

"The evidence adduced during the trial disclosed that the patentee, Ingwer, ever since women decided to wear shoes with wooden heels, *made repeated and numerous attempts to produce a rubber heel or a combination of a rubber heel and some other substance* which would work satisfactorily when attached to the wooden heel. *All prior attempts over a period of ten years had been unsuccessful.* Testimony disclosed that others as well as Ingwer sought the solution of the problem but apparently failed. Numerous methods were described by which skilled workers in the trade experimented. *The history recited showed a long and painstaking search to bring to the public the product which evidently was received with favor, and that it supplied a demand which had existed.* It further demonstrated that the article patented was not a mere obvious and clearly apparent step taken by Ingwer." (Thus deciding against the subjective test.)

"As stated, when the lift manufactured by the Plaintiff under the Ingwer patent *was introduced to the critical requirements of women, it was accepted as satisfactory.* The evidence is clear that the product enjoyed a high degree of commercial success, not as the

result of advertising but because the women users expert in the judging of the success of the item were satisfied that it fulfilled their requirements and unusual demands. The Defendant who copied the lift manufactured by the Plaintiff shared in the commercial success attained.

"Summarized: **A history of existing demand unsupplied, of prior effort and failure, of taking a step not obvious and apparent, a favorable public reception when put on the market, commercial success and duplication by others, all bring this court to the conclusion that the Plaintiff's product possesses patentable novelty and invention.**"

The District Court found (R. p. 455):

"7. The patentee, Ingwer, ever since women decided to wear shoes with wooden heels, made repeated and numerous attempts to produce a rubber heel or a combination of a rubber heel and some other substance which would work satisfactorily when attached to the wooden heel. *All prior attempts over a period of ten years had been unsuccessful. Others skilled in the art sought the solution to the problem but failed. Skilled workers in the trade experimented unsuccessfully by numerous methods.* There was a long and painstaking search to bring to the public the product of the patent in suit, which when produced, was received with favor, and *supplied a demand which had long existed.* The article patented was not a mere obvious and clearly apparent step taken by Ingwer, and did not spring naturally from the expected skill of the art.

"8. When the lift manufactured by the plaintiff under the Ingwer patent was introduced to the critical requirements of women, it was accepted as satisfactory. The product enjoyed a high degree of commercial success, not as the result of advertising, but because the women users expert in the judging of the success of the item were satisfied that it fulfilled their requirements and unusual demands. The defendants, who copied the lift manufactured by the plaintiff, shared in the commercial success attained."

The Court of Appeals Decided the Question "Subjectively" or Contrary to the Recommendation of the Commission:

The Court of Appeals said (R. p. 488):

> "Besides the suggestions in this specialized art itself, it *must have been perfectly obvious to those working in rubber*, that fibre and rubber could be successfully bonded by vulcanization. The practices of the great tire companies in uniting webbed fabric and later cord fabric to rubber by vulcanization, which permitted utilization both of rubber resilience and the restraint of fibrous material (*Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948), must be adjudged as within the knowledge of the art with which we are dealing."

The members of this Court are familiar with the controversy to which the Commission refers and which has raged through the Press, the Courts, the engineering and scientific societies and fraternities, the patent bar, the manufacturing business world, and elsewhere for some years past, regarding the value of the American patent system, past, present and future, what, if any, changes should be made in it, and if any are to be made, how they should be made. We think it is fair to say from some of the dissenting and other opinions of this Court that this Court has, and does, appreciate not only these controversies, but has appreciated the need of investigation and report as to their value, the ways to determine the controversy, and the methods of settling them.* Certainly the President

---

* For example, we find in opinions written by the Justices of this Court such expressions as the following written by Mr. Justice Frankfurter in the *Marconi* case (11 L. W. 4535):

> "I have little doubt, in so far as I am entitled to express an opinion, that the vast transforming forces of technology have rendered obsolete much in our patent law. For all I know the basic assumption of our patent law may be false, and in-

(*Continued on next page*)

of the United States has appreciated all of these things for, as we have said, he appointed the Commission to investigate these questions and determine them, and that the Commission has done. We must all recognize that the Commission has devoted more time and effort, and more careful consideration, to these questions than anyone has ever devoted to them, or than anyone can devote to them. We must recognize in their Report sound recommendations upon these questions based upon these investigations. It would seem to us as members of the Bar, and we assume that it will seem to the members of this Court, as members of the Bench, that it behooves us to accept these recommendations and as expeditiously and as economically as possible aid in the establishing of the policies and machinery for making them effective and for carrying out the recommendations of the Commission, no matter whether we may agree or disagree with some of the Commission's conclusions and recommendations.

The objective method of determining the presence of invention as against mechanical skill is obviously a sound method even independently of the recommendation of the Commission because fundamentally it is predicated, in part at least, upon the failure of mechanics to solve the problem and is, therefore, fact evidence that its solution was not within the skill of the mechanic. The presence of this element or factor in the objective test was found by the District Court and recognized by the Court of Appeals who made the following comments upon it (R. p. 485):

(*Continued from preceding page*)

ventors and their financial backers do not need the incentive of a limited monopoly to stimulate invention. But whatever revamping our patent laws may need, it is the business of Congress to do the revamping. We have neither constitutional authority nor scientific competence for the task."

The Commission has answered all these questions and dispelled all these doubts.

"It is urged that this problem, though recognized in 1918, was not solved until the Ingwer patent issued in 1928, although much effort was expended for ten years both by Ingwer and others in search of solution."

and (R. pp. 487-488):

"The appellee says that forcing the edge of the rubber lift always against the edge of the heel with enough pressure to seal the seam, maintaining this situation during the flexing and unflexing of the heel in response to the tread of the walker, and at the same time limiting this action so that it would not dislodge the edges of the fabric, required a very careful reconciling of antagonisms to provide a kind of automatic force in the lift that would maintain the seam sealed under these conditions and not force the fabric out beyond the edge of the heel; that this was accomplished by a molding and vulcanizing which resulted in a bond between two heterogeneous materials without disruption of either or of the joint."

The presence of the other items or factors necessary for the determination of the question objectively were found as matters of fact in the above quoted findings of fact made by the District Court.

Furthermore, the high importance of the patent system and its proper administration must be accepted from the findings in the Report of the Commission which we have quoted above.* These being accepted, it is equally neces-

---

* These findings confirm the findings of the Senate Monopoly Investigating Committee, headed by Senator O'Mahoney, and handed down about January, 1939, which are as follows:

"1. There seems to be a general agreement by these witnesses, as well as by those who previously testified at the Department of Justice hearings some weeks ago, that inventors and business still need the protection and stimulation of patents.

* * * * *

"the patent system has been of inestimable benefit to the country in promoting industrial and scientific development,

(*Continued on next page*)

sary that the District Court be sustained and the Court of Appeals be reversed in order to forward the declared purpose of the Commission that the American patent system, which has accomplished so much and offers so much more, should be forwarded. Indeed, it is apparent from the decision of the Court of Appeals that that Court would not have come to the conclusion it did on the question of patentability if it had had the Report of the Commission before it. The discussions of the Court show that it was in serious doubt on the question and only resolved against the patentee because of views regarding the value of the American patent system then prevalent which are, and must be, dispelled by the Report of the Commission.

Therefore, we maintain that we present here a question of greater public interest than has existed in the patent law since the laws were first enacted, and that the Court should grant this Petition, take up the case, affirm the District Court and reverse the Court of Appeals.

We have already quoted that portion of the opinion of the Commission which finds that the confusion due to the uncertainty as to what is and is not invention "threatens the usefulness of the whole patent system and calls *for immediate and effective remedy.*" We have also cited those parts which find that the American patent system has

---

(*Continued from preceding page*)

and may be regarded as one of the principal causes of American industrial supremacy,"

* * * * *

"(6) The fact that patents are keystones in many very important industries has been brought home to us with great emphasis. I doubt whether I had realized their significance as a primary force in the operations of the economic system."

* * * * *

"(7) There was practically unanimous agreement among the witnesses that Congress, by the enactment of the Patent Law, has given this country a system far superior to that which exists in any other country."

promoted and encouraged invention which has resulted in promotion of the public welfare, the raising of the standards of living of the public, and increasing prosperity and business. Perhaps there never was a time when it is so important that we should foster and encourage whatever will promote these enterprises as the present time. In the first place, we are engaged in a war which is fundamentally an inventor's war and, therefore, we ought to encourage invention. The Commission has, after its investigation, told us how this is to be done. There is also much concern about post-war conditions. Nothing could solve the post-war problems like the production of new inventions creating new things to be manufactured, sold and used; indeed many of the post-war planners base their hope for post-war prosperity upon the making of new inventions such as the Commission hopes to encourage.

Careful study and consideration of many comments regarding the administration of the American patent system proves that the basis of those comments is often, and the reasons therefor have arisen from, the failure to adhere in the past to the policy now recommended by the Commission.

Invention in the United States has declined about 28% according to the Patent Office records, declining to a 30% low per capita since 1916, since the conditions noted by the Commission became acute approximately ten years ago. Manifestly, this is a condition that not only should, but must, be remedied if there are to be new products, etc. to be made and marketed to create that post-war prosperity which is so ardently sought and so necessary. The Commission has investigated the causes for this decline, ascertained the reasons, and suggested the remedies.

Mr. Justice Frankfurter is not alone in his comments, made in his dissenting opinion in the *Marconi* case, regarding the inappropriateness of burdening Anglo-American Judges with the duties cast upon them by patent legis-

lation. Yet it is astonishing how well and successfully those duties have been performed when rulings have been bottomed, or bottomed mainly, upon considerations made "objectively." When made objectively these tasks are no more difficult and no more burdening than the consideration, the weighing, and the making of decisions upon fact evidence in any branch of litigation. This is because want and need, prior efforts and failures in a particular art, public acceptance and adoption, commercial success, achievement, and the other criteria of invention, are merely facts whose presence or absence can be detected from ordinary evidence such as is present in any form of litigation.

Mr. Justice Roberts joined Mr. Justice Frankfurter's speculations in the *Marconi* case regarding the need of the grant of patents to encourage invention; both are not only answered by the Commission, but by the Monopoly Investigating Committee which also, and independently of the Patent Planning Commission, made an investigation of the patent system and particularly of this subject. The Committee not only found that

> "inventors and business still need the protection and stimulation of patents"

but that

> "the patent system has been of inestimable benefit to the country in promoting industrial and scientific development, and may be regarded as one of the principal causes of American industrial supremacy."

It is difficult, if not impossible, to successfully challenge the concurring conclusions of the Committee and the Commission. Be that as it may, we will never have conclusions or recommendations that are so reliable upon which to determine our course. It is also, of course, important that both the conclusions of the Commission and of the Committee are affirmed by history and by common sense because history not only records that invention did not

succeed until it was stimulated by the incentive of the limited monopoly, but that few, if any, human enterprises have succeeded without incentive. Inasmuch as the success of invention is inseparably linked to business, it is fair to say that in no case has business ever succeeded without the incentive of a return which would at least be equal to the expenditure and so far no one has ever devised a scheme for offering business, in promoting invented devices, etc., such a return except the patent system. Therefore, the findings and the conclusions of both the Commission and the Committee are not only affirmed by the history of the patent system in particular, but by the history of the human race in general. All of these things are important in this particular case because, as we say, the Commission has found that one of the principal obstructions to the success of the patent system is the decision of cases subjectively instead of objectively.

This Court has had occasion to announce that it would ordinarily accept the concurring findings of fact of two Courts below (*Del Pozo v. Wilson,* 269 U. S. 82, 89; *I. T. S. v. Essex,* 272 U. S. 429). Certainly the concurring findings of fact of both the Commission and the Committee should rate as highly in this Court as the concurring findings of two Courts below.

Mr. Justice Douglas' use of the phrase "flash of creative genius" as a name for the qualities which transcend mechanical skill seems to have been very much misunderstood, since it appears that it has been construed as establishing a "subjective" test for invention. That the subjective method is far afield is further illustrated first by Mr. Edison's comment that genius was "2% inspiration and 98% perspiration" and, second, by a reading of the current book on the Wright brothers. Certainly nobody can dispute that the Wright brothers made an invention when they invented the flying machine. A perusal of this book is convincing that the act of invention of the air-

plane by Orville and Wilbur Wright was 1% inspiration and 99% perspiration.

Mr. Justice Rutledge in his dissenting opinion in the *Marconi* case reflects the wisdom of basing decision in patent cases on history; his views therefore find confirmation and affirmance in the recommendations of the Commission.

These are just some of the instances that illustrate the soundness of the recommendation of the Commission that invention be tested objectively and not subjectively.

Indeed, if this Court would adopt the recommendation of the Commission on this test and make such a ruling in this case, there is no reason why the present Courts could not successfully administer the patent law in the future as they have in the past when adhering to the objective principle. A ruling by this Court, adopting the Commission's recommendation, may make unnecessary some of the other plans proposed by the Commission, such as the creating of a special Patent Court of Appeals.

The right and power of this Court to decide patent cases *objectively* cannot be disputed, as the Court has so held frequently in the past (*Expanded Metal v. Bradford,* 214 U. S. 366, 386; *Loom Co. v. Higgins,* 105 U. S. 580, 591; *Temco v. Apco,* 275 U. S. 319, 324). To effect many of the remedies recommended by the Commission and achieve the ends of both the Commission and the Committee, it is, therefore, only necessary for this Court to pronounce the practices which it followed in these cited cases to be the policy of this Court in the administration of the patent law. Such a declaration would have the effect of at once remedying the situations pointed out by the Commission, adopting its recommendations, and avoiding the delay and expense of legislation which the Commission recommends.

It is, therefore, a matter of great public interest and importance to the public that the confusion on the subject of the test of invention which the Commission finds threat-

ens the usefulness of the whole patent system, be remedied immediately and effectively, as the Commission recommends. This remedy can be immediately and effectively applied by this Court taking up the instant case and affirming the District Court.

Point B.

The Court of Appeals made a twin error; that Court not only decided the question of invention subjectively, but decided it on the basis of what would be subjective in an alien art, i.e., the rubber manufacturer's art; the District Court decided the question objectively in the art to which the invention relates, i.e., the shoemaker's art.

Invention in the shoemaker's art cannot be gauged by the subjective test on invention in the rubber manufacture or engineering art or, to carry the proposition to the extreme, subjectively by the test of invention in the radio engineer's art. To take the position that invention in the shoemaker's art must be gauged by the subjective tests of invention in the rubber engineer's art, or the radio engineer's art, would be to hold that there could be no invention in the shoemaker's art. Indeed, to make the same tests and the same criteria subjectively in all of the arts as are made, for example, in the radio engineer's art, or even in the rubber engineer's art, would be to refuse patents to the workers in a great many arts, such as the shoemaker's art, and to still invention and progress in those arts. The difference between the District Court and the Court of Appeals in the instant case is predicated upon the application by the District Court of the objective tests and criteria applicable to the shoemaker's art and the application by the Court of Appeals subjectively of criteria in the alien art of the rubber workers. The District Court said (R. pp. 433-434):

> "In considering the contention that the patent in question is devoid of patentable novelty or invention,

> *one must approach the subject from the point of view of the art involved.* To weigh the invention of a rubber heel or some other simple article in the same light as an intricate piece of machinery would bring about the almost inescapable result, by comparison, that improvement or advance in the field of products which by their very nature are not complex, do not ever reach the dignity of patentable novelty and patent protection. It appears to the court that the query in this instance should be: *Does the article possess patentable novelty when regarded with the eyes of the shoemaker and tested by his requirements?* (*Kurtz v. Belle*, 280 Fed. 277.)"

The Court of Appeals said (R. p. 488):

> "it must have been perfectly obvious to those *working in rubber.*"

The shoe heel involved is not made entirely of rubber. Rubber is only a part of it. The other part is made of fiber board. If it is proper, because of the presence of rubber, to determine the question of invention by the subjective tests and criteria of the rubber art, then it would be equally logical to make the decision predicated upon the subjective tests and criteria in the fiber-board art. A device, therefore, made of several elements would present a question predicated upon several different sets of tests or criteria unless the fatal course of applying subjectively the same tests and criteria to all arts be applied.

If it is proper to range about among a plurality of arts, then it is imperative that the pleadings advise the arts which will be relied upon that proof may be offered to meet the subjective criteria in the various arts.

If it is proper to decide the question by the standards of a different art, then it was error to exclude the evidence on the subjective tests in that other art and for the Court of Appeals to decide the question without that evidence.

Therefore, if this Court should find the District Court in error in deciding the question "objectively" on the evidence offered, and thinks that the question should be decided on what was within the skill of the mechanic in the rubber worker's art, then this Court should remand the cause to the District Court with directions to reopen the case to admit the evidence on this subject which was excluded by the District Court over the objection of the defendant. Otherwise the case stands decided not only subjectively, but subjectively on the basis of an alien art. Not only is this true, but it stands decided on an issue which was never made up, upon which no evidence was offered by defendant, and on which issue evidence proffered by the plaintiff was objected to and excluded.

If this Court holds that the question should be determined objectively, then the tests and criteria of invention in all arts will automatically become the same.

V.

CONCLUSION.

For the reasons stated in the Petition, and elaborated upon in the brief, we respectfully ask this Court to review and reverse the conclusion of the Court of Appeals for the Sixth Circuit and to affirm the District Court in the Northern District of Ohio, Eastern Division, and to hold that the question of invention and mechanical skill should be decided objectively and not subjectively, as the President's National Patent Planning Commission has recommended.

Respectfully submitted,

F. O. RICHEY,

H. F. MCNENNY,

J. D. DOUGLASS,

Counsel for Petitioner.

RICHEY & WATTS,

Of Counsel.